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10/579,814

10/13/2006

Giorgio Panin

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EXAMINER

MATTISON, LORI K

ART UNIT

PAPER NUMBER

1619

NOTIFICATION DATE

DELIVERY MODE

12/20/2011

ELECTRONIC

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

info@lmiplaw.com

| | | | |
|------------------------------|------------------------|---------------------|--|
| Office Action Summary | Application No. | Applicant(s) | |
| | 10/579,814 | PANIN, GIORGIO | |
| | Examiner | Art Unit | |
| | LORI K. MATTISON | 1619 | |

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 06 December 2011.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ An election was made by the applicant in response to a restriction requirement set forth during the interview on ____; the restriction requirement and election have been incorporated into this action.
- 4) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 5) ☒ Claim(s) 16-20 and 22-42 is/are pending in the application.
- 5a) Of the above claim(s) 39-41 is/are withdrawn from consideration.
- 6) ☐ Claim(s) ____ is/are allowed.
- 7) ☒ Claim(s) 16-20, 22-38 and 42 is/are rejected.
- 8) ☐ Claim(s) ____ is/are objected to.
- 9) ☒ Claim(s) 16-20 and 22-42 are subject to restriction and/or election requirement.

Application Papers

- 10) ☐ The specification is objected to by the Examiner.
- 11) ☐ The drawing(s) filed on ____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 12) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 13) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. ____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. ____. |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date ____. | 6) <input type="checkbox"/> Other: ____. |

DETAILED ACTION

Examination Under 37 CFR 1.114

1. A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on December 06, 2011 has been entered.

Claim Status

2. Applicant's arguments and amendments to claim 16, filed 12/06/2011, are acknowledged and have been fully considered.

Claims 16-20 and 22-42 are pending.

Claims 1-15 and 21 are cancelled.

Claims 39-41 remain withdrawn.

Claims 16-20, 22-38, and 42 have been examined on the merits.

New Grounds of Rejection

3. The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

Claim Rejections - 35 USC § 112

The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

4. Claims 16-20, 22-38, and 42 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention. **This is a new matter rejection.**

Instant claim 16 recites a composition which comprises an amount between 0.2 and 1.0% of perfluoropolyether phosphate by weight of the total composition.

The reply filed 12/06/2011 states support for the amendment to claim 16 is found at pg. 6, lines 11-13 and original claim 21 (Reply, pg. 8, ¶ 1). This has been fully considered but is not found persuasive. Amended claim 16 now embraces the subgenera of perfluoropolyether mono-phosphates, perfluoropolyether di-phosphates, and amide-linked perfluoropolyether monophosphate esters. Original claim 21 was drawn to the composition comprising at least one perfluoropolyether diphosphate in an amount of between 0.2 and 1.0%. Therefore, original claim 21 *does not* provide support for a composition which comprises an amount between 0.2 and 1.0% of perfluoropolyether phosphate by weight of the total composition. Pg. 6, lines 11-13 is drawn to cosmetic and/or dermatological compositions containing a perfluoropolyether diphosphate in amount of between 0.1 and 5.0% by weight to the total composition weight and conveniently from 0.2 to 2%.

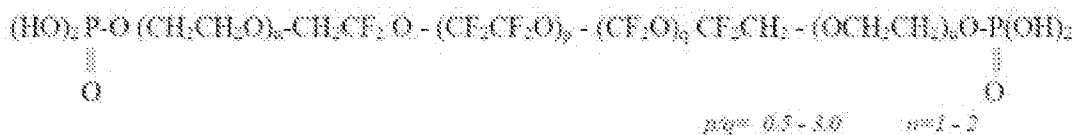
Therefore, pg. 6, lines 11-13 *do not* provide support for a composition which comprises an amount between 0.2 and 1.0% of perfluoropolyether **phosphate** by weight of the total composition. Thus, original claim 21 and pg. 6, lines 11-13 *do not* provide sufficient support for the claim amendments by changing the scope of the disclosure; thereby, constituting new matter. Applicant's amendment to claim 16 necessitated the new grounds of rejection.

5. Claims 16-20, 22-38, and 42 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Amended claim 16 recites the limitations "...an amount between 0.2 and 1.0% of perfluoropolyether phosphate..." and "...said perfluoropolyether phosphate..." It is unclear whether Applicant is utilizing the term "perfluoropolyether phosphate" as a genus (which embraces the subgenera of perfluoropolyether mono-phosphates, perfluoropolyether di-phosphates, and amide-linked perfluoropolyether monophosphate esters), a species (i.e. perfluoropolyether monophosphate) or are utilizing the "other chemical name" for the compound of CAS Number 200013-65-6 (which is the diphosphate shown below):

FOMBLIN® HC/P2-1000

Chemical Structure



Identification

| | |
|------------------------------|---|
| <i>INCI Name:</i> | Polyperfluoroethoxymethoxy Difluoroethyl PEG Phosphate |
| <i>Other Chemical Names:</i> | Perfluoropolyether phosphate, Perfluoropolyether acid phosphate, Perfluoropolyether PEG phosphate, PFPE-1000 phosphate |
| <i>CAS Number:</i> | 200013-65-6 |
| <i>CAS Name:</i> | Diphosphoric acid, polymers with ethoxylated reduced Me esters of reduced poly(m, oxidized tetrafluoroethylene |
| <i>EINECS Number:</i> | Not applicable (since it is a polymer) |

Dependent claim 19 suggests claim 16 is a **GENUS** claim by reciting, "...wherein the perfluoropolyether phosphates are...." while dependent claim 17 suggests that claim 16 is a **SPECIES** by reciting "... a perfluorether diphosphate..." As such the metes and bounds of claim 16 can not be determined and therefore the claim is indefinite.

Amended claim 16 recites the limitation, "...comprising, as active substances, polyphenols in association..." It is unclear whether "polyphenols" means several molecules of one kind of polyphenol or several different kinds of polyphenols. As such the metes and bounds of claim 16 can not be determined and therefore the claim is indefinite.

Claim 17 recites the limitation "said stabilizing agent" in line 2. There is insufficient antecedent basis for this limitation in the claim.

Claim 19 recites the limitation " perfluoropolyether phosphates." There is insufficient antecedent basis for this limitation in the claims.

Claims 20 and 22 recite the limitation " wherein said at least one perfluoropolyether diphosphate." There is insufficient antecedent basis for this limitation in the claims.

Claims 23 and 24 recite the limitation " wherein said polyphenol content..." There is insufficient antecedent basis for this limitation in the claims.

Applicant's amendment necessitated the new grounds of rejection.

Rejection of Claims under 35 U.S.C. § 112, ¶ 4

The following is a quotation of the fourth paragraph of 35 U.S.C. 112:

Subject to the following paragraph, a claim in dependent form shall contain a reference to a claim previously set forth and then specify a further limitation of the subject matter claimed. A claim in dependent form shall be construed to incorporate by reference all the limitations of the claim to which it refers.

6. Claims 17-20, 22-24, 26, 27, 29, 30 and 42 are rejected under 35 U.S.C. 112, ¶ 4, as being of improper dependent form for failing to further limit the subject matter of a previous claim.

For this rejection, the term "perfluoropolyether phosphate" as recited by claim 16 is reasonably interpreted as the species" perfluoropolyether monophosphate."

Claim 17 depends from claim 16. Claim 16 recites the composition contains an amount between 0.2 and 1.0% perfluoropolyether phosphate. Claims 17, 20, and 22 recite the limitation "perfluoropolyether diphosphate." Therefore, claims 17, 20, and 22 do not include every limitation of the base claim and fail to further limit the subject matter recited by instant claim 16.

Claim 19 recites the limitation "perfluoropolyether phosphates." Therefore, claim 19 does not include every limitation of the base claim and fails to further limit the subject matter recited by instant claim 16.

Any claim which is in dependent form but which is so worded that it, in fact is not, as, for example, it does not include every limitation of the claim on which it depends, will be required to be canceled as not being a proper dependent claim; and cancelation of any further claim depending on such a dependent claim will be similarly required. Applicant is required to cancel the claim, or amend the claim to place the claim in proper dependent form, or rewrite the claim in independent form.

Applicant's amendment necessitated the new grounds of rejection.

Maintained Rejections

7. Claims 16, 20, 23, and 38 stand rejected under 35 U.S.C. 103(a) as being unpatentable over PANTINI in view of CHEETHAM for the reasons of record in the Examiner's Answer mailed on 10/07/2011 and as follows.

Claim Interpretation: Based upon the prosecution history, specification, and instant claim 17, it appears that it is Applicant's intention to claim a composition comprising a perfluoropolyether diphosphate of General Formula I. To aid in a more compact prosecution, the terms, "perfluoropolyether phosphate" and "perfluoropolyether phosphates," recited by instant claims 16 and 19 has been interpreted as "perfluoropolyether diphosphate."

PANTINI teaches inclusion of the perfluoropolyether phosphate in an amount of 0.5% by weight of the composition (§ 25; as applies to instant claim 16). PANTINI teaches inclusion of 0.5% by weight of the composition perfluoropolyether phosphate in the cosmetic gel of Example 26 (§ 97; as applies to instant claim 16). PANTINI teaches this amount of perfluoropolyether

phosphate had hydro and oil repellence in accordance to the invention (§ 99 and Table 5; as applies to instant claim 16).

Response to Arguments

Applicant requests to incorporate by reference the response filed on May 2, 2011 (Reply, pg. 9).

Applicant's request is acknowledged. The examiner incorporates by reference the Advisory Action (Paper No. 20110513) and the Examiner's Answer to the Appeal Brief mailed 10/07/2011.

Applicant argues PANTINI describes a sun cream which includes an amount of perfluoropolyether phosphate "...way beyond the amount presently claimed" (Reply, pg. 9, last ¶). Applicant argues the claimed composition represents between 0.2 and 1% by weight perfluoropolyether phosphates whereas PANTINI discloses amounts of at least 3% (Reply, pg. 9, last ¶).

Applicant's arguments are not persuasive. The sun creams taught by PANTINI are gels (§s 78 and 80). PANTINI teaches inclusion of the perfluoropolyether phosphate in an amount of 0.5% by weight of the composition (§ 25). PANTINI teaches inclusion of 0.5% by weight of the composition perfluoropolyether phosphate in the cosmetic gel of Example 26 (§ 97). PANTINI teaches this amount of perfluoropolyether phosphate had hydro and oil repellence in accordance to the invention (§ 99 and Table 5). Therefore, the recited amount of 0.2 and 1% by weight perfluoropolyether phosphates is *prima facie* obvious.

Applicant argues there is no motivation to combine PANTINI and CHEETHAM because the sun cream of PANTINI already comprises UV screening substances (Reply, pg 10, ¶ 1).

In response, M.P.E.P. § 2144 IV states "Rationale Different From Applicant's is Permissible". "The reason or motivation to modify the reference may often suggest what the inventor has done, but for a different purpose or to solve a different problem."

In the instant case, PANTINI teaches cosmetics for "the protection against sun radiations..." and claims inclusion of sun filters (PANTINI's claims 12 and 18). CHEETHAM explicitly teaches caffeic acid (i.e. a polyphenol) has *advantageous* UV absorption qualities (CHEETHAM, col. 12, lines 30-55); CHEETHAM even *embodies* use of caffeic acid (i.e. polyphenol) in a *sunscreening composition* (i.e. a sun cream; CHEETHAM, col. 12, lines 30-55). Thus, the ordinary skilled artisan would have been motivated to add the caffeic acid (i.e. polyphenol) taught by CHEETHAM to the composition taught by PANTINI because caffeic acid (i.e. polyphenol) is an *advantageous* UV absorber utilized in sunscreening compositions as taught and *embodied* by CHEETHAM.

Applicant argues none of PANTINI or CHEETAM recognize that the perfluoropolyether phosphates stabilize the oxidative degradation of polyphenols contained in the cosmetic composition (Reply, pg. 10, ¶ 1).

Applicant's argument is not persuasive. The fact that applicant has recognized another advantage which would flow naturally from following the suggestion of the prior art cannot be the basis for patentability when the differences would otherwise be obvious. See *Ex parte Obiaya*, 227 USPQ 58, 60 (Bd. Pat. App. & Inter. 1985). Accordingly, since the combination of PANTINI and CHEETHAM teach the recited reagents in the recited amounts, the composition

would necessarily have the characteristic of preventing oxidative degradation of the polyphenol (i.e. caffeic acid).

Further, the stabilizing (per)fluoropolyether used by Appellant and taught by PANTINI was Fomblin HC/P2-1000 (instant specification, pg. 9, lines 15-20; PANTINI-Example 17a, ¶ 78). Since the product used by the Appellant and the product taught by PANTINI are the same chemical and have the same chemical structure, the Fomblin HC/P2-1000 (per)fluoropolyether of PANTINI is necessarily stabilizing. Notably, Applicant has not provided *evidence* the composition taught by PANTINI in view of CHEETHAM is not stabilizing and does not prevent the oxidative degradation of the polyphenol. “It is not invention to perceive that the product which others had discovered had qualities they failed to detect.”); *In re Wiseman*, 596 F.2d 1019, 1023 [201 USPQ 658] (CCPA 1979).

8. Claims 16-20, 22-24, 38, and 42 stand rejected under 35 U.S.C. 103(a) as being unpatentable over PANTINI and CHEETHAM as applied to claims 16, 20, 23, and 38 above, and further in view of SCHLIEMANN-WILLERS (as evidenced by Fomblin HC/P2-1000 product information sheet) for the reasons of record in the Examiner's Answer mailed on 10/07/2011.

9. Claims 16-20, 22-30, 38, and 42 stand rejected under 35 U.S.C. 103(a) as being unpatentable over PANTINI, CHEETHAM and SCHLIEMANN-WILLERS (as evidenced by the Fomblin HC/P2-1000), as applied to claims 16-20, 22-24, 38, and 42 above and further in view of RANDALL for the reasons of record in the Examiner's Answer mailed on 10/07/2011.

10. Claims 16-20, 22-30, 35, 36, 38, and 42 stand rejected under 35 U.S.C. 103(a) as being unpatentable over PANTINI, CHEETHAM, SCHLIEMANN-WILLERS, AND RANDALL (as evidenced by the Fomblin HC/P2-1000 product information sheet) as applied to claims 16-20, 22-30, 38 and 42 above, and further in view of SIDDIQUI for the reasons of record in the Examiner's Answer mailed on 10/07/2011.

11. Claims 16-20, 22-38, and 42 stand rejected under 35 U.S.C. 103(a) as being unpatentable over PANTINI, CHEETHAM, SCHLIEMANN-WILLERS, RANDALL, and SIDDIQUI (as evidenced by the Fomblin HC/P2-1000 product information sheet) as applied to claims 16-20, 22-30, 35, 36, 38, and 42 above, and further in view of MENZEL for the reasons of record in the Examiner's Answer mailed on 10/07/2011.

Response to Arguments Made Under "Additional Rejections"

Applicant argues claim 16 is patentable , therefore, all other claims are patentable (Reply, pgs 10-11).

Applicant's argument is not persuasive. For the reasons stated above, claim 16 is unpatentable over PANTINI in view of CHEETHAM.

Conclusion

12. No claims allowed.

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13. Any inquiry concerning this communication or earlier communications from the examiner should be directed to LORI K. MATTISON whose telephone number is (571)270-5866. The examiner can normally be reached on 8am-6pm (Monday-Thursday).

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, DAVID BLANCHARD can be reached on (571)272-0827. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/LORI K MATTISON/
Examiner, Art Unit 1619
December 8, 2011

/ROBERT C. HAYES/
Primary Examiner, Art Unit 1649